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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,093	05/24/2001	Eddy Daelmans	501139	2724

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

13

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,093

Applicant(s)

DAELMANS ET AL.

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

This Office Action is responsive to the amendment filed June 24, 2003. The 112 rejections are maintained below, others to the aforementioned issues have been withdrawn. The objection is withdrawn.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 19 (new) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner believes that claim 19 (new) does not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on co-extruded films or its usage with Applicant's claimed packaging.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. In claim 10, the phrase "intended to be closed" is indefinite as it lends no positive recitation to the claim. It is not definite as to whether the sheets are closed.

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7. Regarding claim 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
8. The phrase "adapted to be cut/closed" are indefinite, as the phrase does not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.
11. Claims 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 3,055,576 to Ottinger et al.

Ottinger teaches a wrapping material that is wound, comprising a web, where a water

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proof stripe (strip) of self-sealing latex adhesive on two outer edges of the web (inner and outer strips), which does not adhere to a surface when pressed against another surface such as in the wound roll. Such explanation is a functional equivalent to Applicant's new limitation to the mutual contact relationship between the inner and outer strips in a wound state on the roll. See col. 1, lines 20-31, col. 2, lines 1-35, col. 3, lines 5-28, and Figures 1-5. Ottinger explains at col. 3, line 26 that such a wrapping may be suitable for other materials besides carpet to wrap elongated objects. Ottinger shows a traverse edge in Figure 1 and at col. 2, lines 24-25 and 60-65. In regards to the strength of the adhesive e.g. "strong enough...but not strong enough...", Ottinger explains the adhesive is pressed against the margins of the web adhered to one another, but not to a surface which doesn't have the adhesive at col. 2, lines 5-17, which avoids the roll sticking together. Since the adhesive is in a roll and it doesn't stick to the roll, this explanation is functionally equivalent to the description of the strength of the adhesive as Applicant claims.

The process limitations "adapted to be cut/closed" and "...is spread out in the form of an egg-shaped strip" are not dispositive of the issue of patentability of the present article claims. The phrase "adapted to be cut/closed" is indefinite, as the phrase does not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the

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patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

14. Claims 5-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 92/19508 to Jones et al.

Jones teaches a wrapping for food comprised of a web with a cold-seal strips of adhesive on transverse cut edges wound in a roll. The web has an inner face, outer face, longitudinal edges, and traverse edges, with inner and outer cold-seal strips on the web. The paper has a non-stick, release coating of silicon at page 8, lines 19-23. See patented claim 14, abstract, Figures 4, 7, and 8, page 7, lines 9-28, page 8, lines 19-26, page 6, lines 10-25.

The following process limitations are not dispositive of the issue of patentability for the present article claims:

- “arranged to be at least partially superposed, once the sheet has been folded...”  
and
- “...once the sheet has been folded” in claim 5
- “...is deposited at least partially” in claim 6
- “...is spread out in the form of an egg-shaped strip” in claim 7
- “...is preapplied before the sealing coating” in claim 8
- “...is coextruded in the substrate of the sheet” in claim 9
- “...once the sheet has been folded around the article...” in claim 11
- “...arranged at least partially...” in claim 11
- “...holding the folds in place around the said article” in claim 11

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- "...is spread out in the form of an oval strip" in claim 12
- "...is pre-applied under the sealing coating..." in claim 13
- "...is spread out..." in claims 7-9 and 14-18

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

### ***Response to Arguments***

Applicant's arguments filed 6-24-03 have been fully considered but they are not persuasive. Applicant believes "adapted to be cut/closed" is not indefinite as he believes its well known in the art. In response to the phrase "adapted to cut/closed" and language of claim 10, "adapted to" is indefinite, as the phrase does not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.

Applicant alleges that Ottinger does not teach strips coming in contact when stored on a roll. This is not true. Ottinger very well teaches the web in a roll, having the cold-seal strips. See col. 1, lines 20-31, col. 2, lines 1-35, col. 3, lines 5-28, and Figures 1-5.

Applicant alleges that Jones does not teach the strips wound in a roll since a leafing material is present. That the leafing material is present does not take away from the fact that the strips are present, in a roll, thereby teaching the instant invention. See Figure 2.

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Applicant overall disregards the same materials that are provided by both references. How the materials are "adapted" and stored are merely process limitations, as the Examiner has previously stated, are not germane.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus  
Examiner  
Art Unit 1774

July 10, 2003

A handwritten signature in black ink, appearing to read "Bruce Hess", written in a cursive style.

BRUCE H. HESS  
PRIMARY EXAMINER